



PATENT
03000-P0004C WWW/SBS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	Wesley W. Whitmyer, Jr.
Serial No. 09/725,394	Filing Date: November 29, 2000
Title of Application:	Web Site Automating Transfer of Intellectual Property
Confirmation No. 9725	Group Art Unit: 2171
Examiner	Cindy Nguyen

Mail Stop Appeal Brief-Patents
Commissioner for Patents
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Alexandria, VA 22313-1450

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**Notice of Appeal from the Primary Examiner
to the Board of Patent Appeals and Interferences**

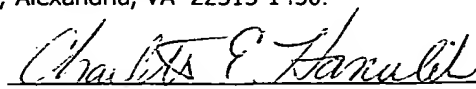
Dear Sir:

Applicant hereby appeals to the Board from the Office Action, mailed October 28, 2003, finally rejecting claims 1-10, all pending claims in the application.

1. **Appeal Brief.** Transmitted herewith, in triplicate, is the Appeal Brief with respect to the Notice of Appeal filed herewith.
2. **Fee for Filing Notice of Appeal.** Pursuant to 37 C.F.R. 1.17(b), the fee for filing this Notice of Appeal is \$165.00. Appellant claims small entity status
3. **Time To Reply.** The final rejection is dated October 28, 2003. The period for response granted therein is three months from the date thereof. Thus, this Notice is timely filed on or before January 28, 2004.
4. **Fee for Filing Appeal Brief.** Pursuant to 37 C.F.R. 1.17(c), the fee for filing the Appeal Brief is \$165.00. Appellant claims small entity status.

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January 7, 2004


Charlotte E. Hanulik




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Notice of Appeal

5. **Request for Oral Hearing.** Appellant hereby requests an Oral Hearing.
6. **Fee for Requesting Oral Hearing.** Pursuant to 37 C.F.R. 1.17(d), the fee for requesting an Oral Hearing is \$145.00. Appellant claims small entity status.
7. **Total Fee Due.** The total fee due is:

Notice of Appeal fee	\$165.00
Appeal Brief fee	\$165.00
Request for Oral Hearing	<u>\$145.00</u>
Total	\$475.00
8. **Fee Payment.** Attached is a check in the amount of \$475.00. This is also a petition and a request to charge to Account No. 19-4516 for any additional extension and/or fee as may be required or credit for any excess fee paid.

Respectfully submitted,

January 7, 2004



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#14

PATENT
03000-P0004C WWW/SBS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re The Application Of

Wesley W. Whitmyer, Jr.

Serial No.: 09/725,394

Filed: November 29, 2000

For: Web Site Automating Transfer
Of Intellectual Property

Examiner: Nguyen, Cindy

Group Art Unit: 2171

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Appeal Brief Under 37 C.F.R. §1.192

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Having filed herewith a Notice of Appeal from the final rejection of Claims 1-10, all of the claims currently pending, the final rejection being mailed on October 28, 2003, Appellant submits its Appeal Brief for the above-captioned application pursuant to 37 C.F.R. §1.192 in triplicate as follows.

Certificate of Mailing: I hereby certify that this correspondence is today being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: : Mail Stop Appeal Brief - Patents; Commissioner for Patents; P.O. Box 1450; Alexandria, VA 22313-1450.

January 7, 2004

Charlotte E. Hanulik
Charlotte E. Hanulik

I. Real Party in Interest

The real party in interest is Wesley W. Whitmyer, Jr.; 198 Old Kings Highway South; Darien, CT 06820.

II. Related Appeals and Interferences

There are no related appeals or interferences.

III. Status Of Claims

Claims 1-10 are currently pending, stand rejected and are the subject of the instant Appeal. A copy of each of these claims is attached hereto as Exhibit A.

IV. Status Of Amendments

Subsequent to the Final Rejection being mailed on October 28, 2003, Appellant has filed no Amendments.

V. Summary Of Invention

As described in the specification, the claimed invention relates to a system for the transfer of property rights. A user may access the system in order to transfer the ownership and legal rights to a particular intellectual property from one entity to another. (*see e.g.*, p. 4 par. 1 and 2; Figures 1 and 2). Software executing on a server aids the user in

accomplishing a desired transfer of property rights. (*see e.g.*, p. 4 par. 1; Figures 1 and 2). The system as claimed in the present application analyzes a property transfer request by a user, selects the proper transfer form, and generates a property transfer document based upon information retrieved by the system. (*see e.g.*, p. 4 par. 2 - 3, p. 5 par. 1 - 3; Figures 1 and 2).

VI. References Cited And Applied

U.S. Patent No. 5,991,751 to Rivette et al.

U.S. Patent No. 6,135,646 to Kahn et al.

VII. Grounds Of Rejection

Claims 1-10 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette et al. in view of Kahn et al.

VIII. Issue Presented For Review

(1) Whether a rejection is proper under 35 U.S.C. 103(a) when even if the references are combined and modified as suggested by the Examiner, the resulting combination does even hint at the elements of the claims.

IX. Grouping of Claims

The claims do not stand or fall together. While independent Claims 1, 3 and 8 are directed to the automated recordation of a property transfer, claims 3 and 8 include patentably distinct limitations from claim 1. Every claim element, feature and limitation is considered material. *See, e.g., Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 1389 (Fed.Cir. 1992).

For instance, claims 3 and 8 require “an intellectual property type identifier, and a jurisdiction identifier”, “each information record including an intellectual property type identifier and a jurisdiction identifier”, “software executing on said Internet server for receiving a reply to said property transfer request form” and “software executing on said Internet server for transmitting said transfer document through the Internet” while claim 1 omits these limitations.

Further, claim 3 requires “software executing on said Internet server for generating a property transfer request form indicative of a transfer of rights to the property; software executing on said Internet server for transmitting said property transfer request form through the Internet; and software executing on said Internet server for receiving said transfer document though the Internet” while claim 1 does not require these limitations.

Additionally, claim 8 requires “software executing on said Internet server for receiving a transfer request indicative of a transfer of rights to the property; software executing on said Internet server for generating a property information request form; software executing on said Internet server for transmitting said property information request form through the internet; and software executing on said Internet server for updating said database containing a plurality of information records” while claim 1 does not require these limitations.

Each of the dependent claims adds specific additional elements to the novel combination of the independent claims. As such, all claims must be considered because it is improper to fail to consider any limitation in the claims. *In re Geerdes*, 491 F.2d 1260, 1262, 180 U.S.P.Q. 789, the 791 (CCPA 1974) (“every limitation in the claim must be given effect rather than considering one in isolation from the others”).

X. Argument

Patents, trademarks, domain names, copyrights, and licenses thereof are often the most valuable assets of a business, however it is not uncommon that companies proceed with commercial transactions with incorrect schedules of intellectual property, or without any recordation of the transfers with the appropriate intellectual property offices around the world. These records can be difficult and expensive to reconstruct. One of the reasons

transfers take place with incorrect data, or are not recorded, is that companies may own properties handled by numerous law firms each of which is undergoing its own mergers, acquisitions and divestitures each of which is probably using a non-compatible tracking system. In addition, third party firms and companies compete for payment of annuities and renewals on each of the properties such that companies may unwittingly transfer responsibility for handling the files.

Perfectlaw™ DocPro™ by Executive Data Systems, Inc, of Coral Gables, Florida has recently begun offering electronic forms for assembly with client data to automate the preparation, prosecution, issue and maintenance of patents and trademarks. These forms however, are not available over the web.

Still further, Internet-based application service providers, so called "ASPs" are known and provide the advantage that hardware and software maintenance and upgrades are centrally managed by a third party and not by each user at its own site. None of these sites, however, provide intellectual property due diligence, transfer or transfer recording services.

Claims 1, 3 and 8 of the present invention are concerned with solving these problems.

The present application is directed toward a system for the transfer of intellectual property rights such as, patents, trademarks and copyrights. To legally transfer these types of intellectual property, specific transfer forms must be filed with, for instance, the United States Patent and Trademark Office. A database containing a plurality of recordation forms may include for instance, any of these standardized forms required to be filed with the United States Patent and Trademark Office. The system can then retrieve data from a database that is specific to an intellectual property and then combine this information with a selected transfer form, which is selected according to the intellectual property to be transferred, to generate a transfer document.

Alternatively, the system claimed in the present application analyzes a property transfer request by a user, selects the proper transfer form from a database of generic recordation forms, and generates a property transfer document based upon combining a retrieved information record with a retrieved recordation form. The claims of the present application require two databases of information, one containing a plurality of information records (i.e. specific information relating to an intellectual property), and the other containing a plurality of generic recordation forms (i.e. standardized forms for transferring intellectual property). All the claims of the present application further require combining the retrieved information record (the specific information relating to the intellectual

property) with the retrieved generic recordation form (the standardized form for transferring the intellectual property) to generate a document.

A. Database Containing A Plurality Of Recordation Forms

The Examiner has submitted that U.S. Patent No. 5,991,751 (“the ’751 patent”) (at 612, 626, 640, Fig. 6 and corresponding text) teaches at least one database containing a plurality of recordation forms accessible by an Internet server. (10/28/03 Office Action, p. 3, lines 1-3). Applicant disagrees. The ’751 patent discloses “Document Databases 612”, “BOM Databases 626” and “Notes Databases 640”, however nowhere does the ’751 patent teach that these databases contain a plurality of recordation forms. (Fig. 6)

For instance the ’751 patent teaches that “the document databases 612 represent the customer’s repository of documents” and also includes “electronic representations of other documents of interest to the customer, such as depositions, pleadings, and prior art references.” (Col. 17, lines 5-6 and 28-30). None of these types of documents comprise a database containing a plurality of generic recordation forms. Instead of generic recordation forms, these are specific litigation documents and/or issued patents.

Likewise “BOM databases 626” does not comprise a database containing a plurality of generic recordation forms either. For instance, the ’751 patent teaches that a “BOM (bill

of materials) group is a group that contains patents (and perhaps other documents) that map to a product, or that map to parts of a product.” (Col. 20, lines 65-67). Again, these documents are issued patents that correspond to particular embodiments of a commercial product. Nowhere does the ’751 patent teach that the BOM (bill of materials) database 626 comprises a database containing a plurality of generic recordation forms.

Still further the ’751 patent teaches that “annotations, linkage information (i.e., information that specifies the link between a note and a portion of a document), and information related to the annotations and/or the linkage information (such as the position of the linked portion in the document, the date of creation, the creator, the date of modification, a note title and/or subject, access rights, etc.) are stored in the notes databases 640.” (Col. 19, lines 1-7). Nowhere does the ’751 patent teach that the notes databases 640 comprises a database containing a plurality of generic recordation forms. Rather, this is simply file specific information.

The Examiner has not submitted U.S. Patent No. 6,135,646 to Kahn et al. (“the ’646 patent”) teaches, discloses or suggests a database containing a plurality of recordation forms as required by all the claims of the present invention and Applicant submits that is does not.

Therefore, applicant respectfully submits that neither the '751 patent nor the '646 patent teach, disclose or suggest a database containing a plurality of recordation forms as required by all the claims of the present application, and therefore no combination thereof can render any claim of the present application obvious.

B. Software For Querying The Database Of Recordation Forms

The Examiner has further submitted that the '646 patent (at Col. 6, lines 32-52) teaches software for querying the database of generic recordation forms to retrieve a specific recordation form corresponding to the specific transfer request. (10/28/03 Office Action, p. 3, lines 12-14). Applicant disagrees.

The '646 patent does not teach or suggest a database of generic recordation forms as argued above and further does not teach software for querying a database of generic recordation forms. Rather, the Examiner has cited a portion of the '646 patent that teaches that the "properties record may contain entries such as the identity of a rights management system 1018 (i.e., the system that has control over transfers of and compensation for right in that object), the handle 1012 for that object, the originator of the object 1020, the name of the object (if any) 1022, a description of any work or other information or material incorporated in the object 1024, the time and date of deposit 1026, format information 1028, and stated terms and conditions in the properties record may allow the user to select

which type of action to allow (e.g. retrieve object or perform object).” (Col. 6, lines 32-43).

This cited portion of the '646 patent is not directed toward software for querying a database of generic recordation forms. Rather this is object specific data that corresponds to a digital object to be transferred over a network connection. (Col. 6, lines 1-31).

Therefore the '646 patent fails to teach or suggest software for querying a database of recordation forms to retrieve a specific recordation form corresponding to the specific transfer request as required by all the claims of the present application, and therefore no combination thereof can render any claim of the present application obvious.

C. Software For Combining The Retrieved Information And Form

The Examiner has submitted that the '646 patent teaches querying a database of recordation forms to retrieve a recordation form corresponding to a transfer request (col. 6, lines 32-52), and for combining the retrieved information record with the retrieved recordation form to generate a document (col. 8, lines 47-55). (10/28/03 Office Action, p. 3, lines 14-17). Applicant disagrees.

Applicant submits that the '646 patent fails to teach or suggest querying a database of recordation forms to retrieve a recordation form corresponding to a transfer request, and

combining the retrieved information record with the retrieved recordation form to generate a document, as required by all the claims of the present application.

Rather, the cited portion of the '646 patent teaches that a “registrar workstation 50 allows a registrar user to view and print rights registration applications and accompanying documents and recordation information and accompanying documents.” (Col. 8, lines 47-50) (emphasis added). The '646 patent further teaches that the “workstation interacts with the registration system to obtain registration application information, with the right management system and repositories to obtain digital objects whose rights are being registered, and with the recordation system to obtain recordation information and associated documents.” (Col. 8, lines 50-55). Nowhere however, does the '646 patent teach that the system itself combines a retrieved information record with a retrieved generic recordation form to generate a document. Instead, the '646 patent teaches that the system allows a registrar user to view and print various documents. Therefore it is the registrar user that makes decisions and selections, but nowhere does the '646 patent teach that the system itself makes a selection of the appropriate form by retrieving the recordation form corresponding to the transfer request and then combines this selected form with a retrieved information record to generate a document, as required by all the claims in the present application.

Therefore, Applicant submits that the '646 patent fails to teach or suggest querying a database of recordation forms to retrieve a recordation form corresponding to a transfer request, and combining the retrieved information record with the retrieved recordation form to generate a document, as required by all the claims of the present invention. The Examiner has not submitted and Applicant submits that the '751 patent also fails to teach or suggest querying a database of recordation forms to retrieve a recordation form corresponding to a transfer request, and combining the retrieved information record with the retrieved recordation form to generate a document, as required by all the claims of the present invention, and therefore no combination of the '646 patent and the '751 patent can render any claim of the present application obvious.

D. No Motivation To Combine The '646 Patent And The '751 Patent

Applicant further respectfully submits that there is no motivation to combine these two references. For instance, while the '751 patent is directed toward a system for processing information related to patents ('751 patent, abstract), the '646 patent is directed toward a system for managing digital objects in a network such that the terms and conditions under which the digital objects are accessed by users are controlled. ('646 patent, abstract). Nowhere does the '646 patent teach or suggest addressing problems associated with transferring or assigning the rights to a patent. This is a very specific legal procedure. For instance, assigning the rights to a United States Patent requires the filing of

specific forms with the United States Patent and Trademark Office. The '646 patent fails to teach or suggest addressing this problem or in any way providing the specific recordation forms needed to accomplish this specific type of transfer, because the '646 patent is not directed toward transferring patents.

E. Response To Argument Regarding “Recordation Forms”

The Examiner has submitted that Applicant's arguments are “not persuasive” because they “are largely based on the meaning of “recordation forms”, which first appear in the disclosure in the claims” and to which there “is no explicit definition of this term that excludes the patents and/or other documents of Rivette et al.” (Advisory Action dated December 4, 2003, p. 2, continuation of item #5)

Applicant submits that every term in the claims does not have to be explicitly defined and that the term “recordation forms” must be interpreted to encompass what one of ordinary skill in the art would understand. *See Eastman Kodak Co. v. Goodyear Tire & Rubber*, 114 F.3d 1547, 1555, (Fed. Cir. 1997) *overruled on other grounds* by *Cybor Corp. v. FAS Technologies, Inc.*, 138 F.2d 1448 (Fed. Cir. 1998) (en banc). The term “recordation forms” cannot encompass the patents and/or other documents as submitted by the Examiner. For instance, if the “database of recordation forms” included patents and other documents as suggested by the Examiner, combination of “the retrieved information record with the

retrieved recordation form to generate a document” would not result in a document that may be used “for automating the recordation of a property transfer” as required by all the claims. Rather, one of ordinary skill in the art would understand that “recordation form” is a generic recording form that is selected by the system and is then combined with the retrieved information record to generate a recordation document that may be filed with the appropriate authority.

While the Examiner has submitted that the database of recordation forms may include patents and/or other documents, Applicant submits that it is rather the “database of intellectual property information records 34” that contains the information record on specific intellectual property, not the database of recordation forms. (Application p. 4, lines 13-22). Rather, as described in the written specification, the database of documents or recordation forms comprises the documents necessary to complete the legal transfer and does not comprise the information that is entered on the recordation forms. (Application p. 4, lines 13-22).

Applicant therefore submits that the term “recordation form” does not require an explicit definition as suggested by the Examiner, but rather one of ordinary skill in the art would understand “recordation form” to be a form or document on which information

relating to a specific intellectual property to be transferred may be entered for recordation of the transfer of the specific intellectual property.

XI. Conclusion

Appellant has made a significant advance over the prior art by providing a system and method for automatically accessing property transfer information and generic forms and for generating documents in a format that is acceptable to the United States governmental agency with which the transfer documents must be filed. Accordingly, reconsideration and allowance of all pending claims is believed in order, and such action is earnestly solicited.

Respectfully submitted,

January ____, 2004

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EXHIBIT A - Pending Claims

1. (previously amended) A system for automating the recordation of a property transfer comprising:

an Internet server;

a communications link between said Internet server and the Internet;

at least one database containing a plurality of information records accessible by said Internet server, each information record including an intellectual property identification number;

at least one database containing a plurality of recordation forms accessible by said Internet server;

software executing on said Internet server for receiving a transfer request indicative of a transfer of rights to the property; and

software executing on said Internet server for querying said database of information records to retrieve an information record corresponding to a transfer request, for querying said database of recordation forms to retrieve a recordation form corresponding to said transfer request, and for combining the retrieved information record with the retrieved recordation form to generate a document.

2. (original) The system of claim 1 wherein said property is intellectual property such as patents, copyrights, and trademarks.

3. (previously amended) A system for automating the recordation of a property transfer comprising:

- an Internet server;
- a communications link between said Internet server and the Internet;
- at least one database containing a plurality of information records accessible by said Internet server, each information record including an intellectual property identification number, an intellectual property type identifier, and a jurisdiction identifier;
- at least one database containing a plurality of recordation forms accessible by said Internet server, each information record including an intellectual property type identifier and a jurisdiction identifier;
- software executing on said Internet server for generating a property transfer request form indicative of a transfer of rights to the property;
- software executing on said Internet server for transmitting said property transfer request form through the Internet;
- software executing on said Internet server for receiving a reply to said property transfer request form;
- software executing on said Internet server for querying said database of information records to retrieve an information record corresponding to said property transfer request, for querying said database of recordation forms to retrieve a recordation form corresponding to said property transfer request, and for combining the retrieved information record with the retrieved recordation form to generate a transfer document;

software executing on said Internet server for transmitting said transfer document through the Internet; and

software executing on said Internet server for receiving said transfer document through the Internet.

4. (original) The system of claim 3 wherein said property is intellectual property such as patents, copyrights, and trademarks.

5. (original) The system of claim 3 further comprising of software executing on said Internet server for receiving an executed transfer document.

6. (original) The system of claim 3 further comprising of software executing on said Internet server for transmitting an executed transfer document.

7. (original) The system of claim 3 further comprising of software executing on said Internet server for transmitting said executed transfer document to a property recordation authority.

8. (previously amended) A system for automating the recordation of a property transfer comprising:

an Internet server;

a communications link between said Internet server and the Internet;

at least one database containing a plurality of information records accessible by said Internet server, each information record including an intellectual property identification number, an intellectual property type identifier, and a jurisdiction identifier;

at least one database containing a plurality of recordation forms accessible by said Internet server, each information record including an intellectual property type identifier and a jurisdiction identifier;

software executing on said Internet server for receiving a transfer request indicative of a transfer of rights to the property;

software executing on said Internet server for querying said database of information records to retrieve an information record corresponding to a transfer request, for querying said database of recordation forms to retrieve a recordation form corresponding to said transfer request, and for combining the retrieved information record with the retrieved recordation form to generate a transfer document;

software executing on said Internet server for transferring said transfer document through the Internet;

software executing on said Internet server for generating a property information request form;

software executing on said Internet server for transmitting said property information request form through the internet;

software executing on said Internet server for receiving a reply to said property transfer request form;

software executing on said Internet server for querying said database of information records to retrieve information records corresponding to said intellectual property information request; and

software executing on said Internet server for updating said database containing a plurality of information records.

9. (original) The system of claim 8 wherein said property is intellectual property such as patents, copyrights, and trademarks.

10. (original) The system of claim 8 further comprising of software executing on said Internet server for retrieving said updates to said database containing a plurality of information records through the Internet from a plurality of sources.